

Patent No. 6,589,481. Claims 1, 2 and 6 to 8 stand rejected on the grounds of obviousness type double patenting over claims 1, 26, 13 and 18 of U.S. Patent No. 6,203,756. Claims 1, 2, 6 and 8 stand rejected on the ground of obviousness type double patenting over claims 1, 12, 13 and 22 of U.S. Patent No. 6,187,266. Applicants respectfully traverse the rejections and request reconsideration and reexamination of the application.

The Examiner has rejected claims 1 and 6 to 8 over Fry et al. and Addy et al. Further, the Examiner rejected the remaining claims over these two references in combination with some additional references. There is no suggestion for making the alleged combination and even if made it would fail to reach the claimed invention. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absence some teaching, suggestion, or incentive supporting the combination." *In re bond*, 15 USPQ2nd 1566, 1568 (FedCir 1990). The Examiner has failed to provide the proper teaching suggestion or incentive supporting this combination. Rather, the Examiner has merely stated the teachings of the references and asserted without further justification that the combination would be obvious. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facia* case of obviousness. Furthermore, even if the references were combined, the alleged combination would fail to reach the claimed invention. If the teachings of these two references were to be combined it would result in a two step process in which first an object might be washed in the device of Fry et al. and then afterward removed from the device of Fry et al. and processed in the device of Addy et al. It would not lead to the step of vaporizing a liquid substance in the same container in which the cleaning and rinsing had occurred.

The only place where the motivation for making this combination occurs is in Applicant's specification. The combination of Fry et al. Addy et al. amounts to nothing more than hindsight reconstruction of the invention. Each of the remaining rejections under 35 U.S.C. §103(a) rely upon the same combination of Fry et al. and Addy et al. and suffer the same flaw. Accordingly, Applicants submit that each of the claims patentably defines over Fry et al. and Addy et al. and the additional referenced cited by the Examiner.

The Examiner has rejected claims 1 and 4 to 8 on the ground of obviousness type double patenting over claims 16, 21 and 24 of U.S. Patent No. 6,589,481. These claims define a method for pretreating a device with hydrogen peroxide and then processing it in a vacuum sterilization chamber. There is nothing in these claims which speak to the steps of cleaning and rinsing the device in the same container in which the vaporization of sterilant occurs. Accordingly, Applicants respectfully submit that claims 1 and 4 to 8 are patentably distinct from claims 16, 21 and 24 of the '481 patent.

The Examiner has rejected claims 1, 2 and 6 to 8 as being unpatentable over claims 1, 26, 13 and 18 of U.S. Patent No. 6,203,756 and also over claims 1, 12, 13 and 22 of U.S. Patent No. 6,187,266. An appropriate terminal disclaimer is enclosed herewith.

Applicants submit that the application is presently in condition for allowance. Favorable reconsideration and early notice of allowance are earnestly solicited. If it would speed prosecution, the Examiner is encouraged to contact the undersigned attorney by telephone.

Respectfully submitted,

By: /Andrew C. Farmer/
Andrew C. Farmer
Reg. No. 35,868

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2825
Dated: January 16, 2007